

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MASARU NOGAMI

Appeal No. 1998-1117
Application 08/220,756

ON BRIEF

Before KRASS, FLEMING, and DIXON, Administrative Patent Judges.

FLEMING, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1 and 2, all the claims pending in the application.

The invention relates to automated teller machines. In particular, the invention relates to automated teller machines

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which include two or more customer operation stations and one or more cash handling mechanisms, wherein the cash handling mechanisms are capable of servicing more than one of the customer operation stations.

The only claims present in the application are reproduced as follows:

1. An automatic teller machine for dispensing currency in response to customers' requests, said automatic teller machine comprising:

at least two customer operation stations operable independently of one another and concurrently with one another;

at least one cash handling mechanism, said number of cash handling mechanisms being fewer in number than the number of said customer operation stations, each of said cash handling mechanisms including a currency storage portion, a currency counting portion and a currency transport portion, said cash counting portion withdrawing a requested amount of currency from said currency storage portion and counting the withdrawn currency, said cash transport portion transporting the counted currency to a cash output port of a selected customer operation station; and

a controller for determining which of the currency withdrawal requests made concurrently in a competing manner by customers to said cash handling mechanism should take priority over the other currency withdrawal requests and for allowing said cash handling mechanism to respond to the selected currency withdrawal request accordingly.

2. An automated teller machine for dispensing currency in response to customers' requests, said automated teller machine comprising:

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at least three customer operation stations operable independently of one another;

at least two cash handling mechanisms wherein the number of said cash handling mechanisms is fewer in number than said customer operation stations and each of said cash handling mechanisms normally handles specific customer operation stations; and

a controller for determining if one of said cash handling mechanism fails and for controlling each functional cash handling mechanism to respond to said customers' requests normally handled by said failed cash handling mechanism.

The references relied on by the Examiner are as follows:

Granzow et al. (Granzow)	4,521,008	Jun. 4,
1985		
Oota et al. (Yoshihiko)(JP)	62-010788	Jan. 19,
1987		
Ito (JP)	4-75165	Mar. 10, 1992

Claim 1 stands rejected under 35 U.S.C. § 103 as being unpatentable over Ito and Yoshihiko. Claim 2 stands rejected under 35 U.S.C. § 103 as being unpatentable over Ito, Yoshihiko and Granzow.

Rather than repeat the arguments of Appellant or the Examiner, we make reference to the brief and answer for the details thereof.

OPINION

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After careful review of the evidence before us, we agree with the Examiner that claim 1 is properly rejected under 35 U.S.C. § 103. However, we do not agree with the Examiner that claim 2 is properly rejected under 35 U.S.C. § 103. Thus, we will sustain the rejection of claim 1 but we will reverse the rejection of claim 2 for the reasons set forth **infra**.

On pages 8 and 9 of the brief, Appellant argues that the proposed combination under 35 U.S.C. § 103 of Ito and Yoshihiko does not disclose or suggest Appellant's invention as recited in claim 1. In particular, Appellant argues that Ito does not suggest a shared mechanical device mechanically coupled to any of the ATMs to provide an output to a customer at a selected one of ATMs. Appellant does not believe that sending of multiple electrical signals to a remote device to record all of the signals teaches or suggests sharing of a mechanical device which physically provides an outlet to a customer at a selected customer service station as Appellant's invention provides. Specifically, Appellant points to claim 1 language requiring "transporting the counted currency to a cash outlet port of a selected customer operation station."

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The Federal Circuit states that "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." **In re Fritch**, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992), **citing In re Gordon**, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). It is further established that "[s]uch a suggestion may come from the nature of the problem to be solved, leading inventors to look to references relating to possible solutions to that problem." **Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.**, 75 F.3d 1568, 1573, 37 USPQ2d 1626,1630 (Fed. Cir. 1996), **citing In re Rinehart**, 531 F.2d 1048, 1054, 189 USPQ 143, 149 (CCPA 1976) (considering the problem to be solved in a determination of obviousness). The Federal Circuit reasons in **Para-Ordnance Mfg. Inc. v. SGS Importers Int'l Inc.**, 73 F.3d 1085, 1088-89, 37 USPQ2d 1237, 1239-40 (Fed. Cir. 1995), **cert. denied**, 519 U.S. 822 (1996), that for the determination of obviousness, the court must answer whether one of ordinary skill in the art who sets out to solve the problem and who had before him in his workshop the prior art, would have been reasonably

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expected to use the solution that is claimed by the Appellants.

However, "[o]bviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor."

Para-Ordnance Mfg., 73 F.3d at 1087, 37 USPQ2d at 1239, **citing W. L. Gore**, 721 F.2d at 1551, 1553, 220 USPQ at 311, 312-313.

In addition, our reviewing court requires the PTO to make specific

findings on a suggestion to combine prior art references. **In re Dembiczak**, 175 F.3d 994, 1000-01, 50 USPQ2d 1614, 1617-19 (Fed. Cir. 1999).

We agree with the Appellant that Ito does not teach a cash handling mechanism that transports the counted currency to a cash outlet port of a selected customer operation station. However, the Examiner is not relying on Ito for this limitation. The Examiner instead is relying on Yoshihiko.

The Examiner is relying on Ito's teaching of the shared printer has a reason for combinability of the Ito system with the Yoshihiko teachings of a shared cash handling mechanism. We agree with the Examiner's reasoning on this point. Furthermore, we wish to buttress his reasoning by pointing out

that Yoshihiko further provides reasons to those skilled in the art for combining the Yoshihiko shared cash handling mechanism with Ito. Yoshihiko teaches on page 3 that there is a need to minimize the number of motors, which are driving the means actuating a teller machine or an automatic teller machine, so as to save space and reduce cost. From these findings by the Examiner of the prior art suggestions and reasons, we find that the Examiner has made a proper **prima facie** case in establishing that Appellant's claim 1 is properly rejected under 35 U.S.C. § 103.

Appellant further argues that Yoshihiko does not provide means for handling requests received concurrently for both bill ports. The Examiner agrees that Yoshihiko does not specifically state that the operation is done concurrently and independently. However, the Examiner points out that those skilled in the art would recognize the need to process request made concurrently.

We note that requests from devices to a shared controller must be properly prioritized and handled so that these requests are not lost was well known in the art. In particular, we point to page 6 of Ito in which the shared

printer must properly process requests from the two separate automatic cash transaction machines. In particular, Ito discloses that the requests are each stored in memory as they are generated and then are processed in the order in which they have been received. We find from this teaching of Ito that those skilled in the art would recognize that the controller for the cash handling mechanism must process concurrent requests in a proper manner by using the Ito's controller to process these requests in the priority as disclosed.

We note that Appellant has not made any further arguments as to claim 1, therefore, we find that the Appellant has not pointed out an error in the Examiner's establishment of a **prima facie** case. Therefore, we will sustain the Examiner's decision of rejecting claim 1 under 35 U.S.C. § 103.

Turning to the rejection of claim 2 under 35 U.S.C. § 103, Appellant argues on pages 10 through 12 of the brief that the proposed combination of Ito, Yoshihiko and Granzow does not disclose or suggest having a normal operation less than all of the cash handling mechanisms to route cash to selected outlet stations. Appellant further points out that Granzow

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teaches that the mechanical components for each dispenser to operate independently is provided and no elements are shared unless the element is inoperative.

We note that Appellant's independent claim 2 recites an automated teller machine comprising: at least three customer operation stations operable independent of one another; at least two cash handling mechanisms wherein the number of cash handling mechanisms is fewer in number than said customer operation stations . . . a controller for determining if one of the cash handling mechanism fails and for controlling each functional cash handling mechanism to respond to said customers' request normally handled by said failed cash handling mechanism. We note that the scope of claim 2 requires at least three customer operation stations and at least two cash handling mechanisms operable to serve these cash handling mechanisms.

We fail to find that the prior art suggests using two cash handling mechanisms and at least three customer operation stations. We agree that the combination of Ito and Yoshihiko teach the use of one cash handling mechanism serving multiple customer operation stations. However, the Examiner has failed

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to show that this combination would have suggested to those skilled in the art to have more than one cash handling mechanism serving a greater number of customer operation stations. Granzow does not fill this gap. Granzow teaches a system in normal operation having at least one cash handling mechanism for each customers' operation station. Therefore, we will not sustain the Examiner's rejection of claim 2 under 35 U.S.C. § 103.

In view of the foregoing, the decision of the Examiner rejecting claim 1 under 35 U.S.C. § 103 is affirmed; however, the decision of the Examiner rejecting claim 2 under 35 U.S.C. § 103 is reversed.

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No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

AFFIRMED-IN-PART

	Errol A. Krass)	
	Administrative Patent Judge)	
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)	
	Michael R. Fleming)	BOARD OF
PATENT	Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
	Joseph L. Dixon)	
	Administrative Patent Judge)	

MRF:tdl

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